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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,888	09/21/2001	Sachiko Tajima	211653US0	2424

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,888

Applicant(s)

TAJIMA ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of Amendment B and Information Disclosure filed on August 12, 2002 are acknowledged. Receipt of Information Disclosure filed on October 2, 2002 is acknowledged. Receipt of Supplementary Amendment C and Information Disclosure filed on November 29, 2002 is acknowledged. Claims 1-3 and 5-16 are included in the prosecution of this application. Claim 4 is cancelled.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Sekiguchi et al do not teach a hair dye or coloring composition. It is argued that the formulation does not contain at least one ingredient of group B. Lastly it is argued that cis-3-hexanol is only one example out of a very long list of fragrances.

The examiner points out that the instant claims are composition claims, therefore the intended use, i.e. in an oxidation hair coloring or bleach formulation, is not given patentable weight unless there is a structural limitation. Additionally, the function of each component is not given patentable weight. Secondly, the examiner points out the claims recite two ingredients: cis-hexenol and one ingredient from the list of ammonia, monoethanolamine, or an aromatic alcohol. Sekiguchi fulfills this requirement by disclosing a perfume composition containing 0.5% cis-hexenol on column 23, line 62 and 2.5% phenyl ethyl alcohol on column 24, line 12, this perfume is blended with a hair composition (example 3). The examiner also points out that the instant claim language does not exclude other fragrances in the composition. Lastly, a reference need only provide one example disclosing the instant composition to anticipate an invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of claims 1-3, 5-6, 9-11, and 16 under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al (5190747) are maintained.

Sekiguchi et al disclose a perfume composition containing cis-3-hexanol (.5%), instant fragrances in claims, and an aromatic alcohol (2.5%) (phenyl ethyl alcohol) (Note col. 23, Perfume II). This perfume is added into a shampoo containing surfactants and silicone derivatives (Note example 27).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Lang et al briefly mentions perfume as a composition excipient and there is no teaching that the perfume is used to mask the smell of ammonia. It is argued that Lang does not teach cis-hexenol. Applicant argues that Sekiguchi et al and JP disclose cis-hexenol but neither discloses it in an oxidation/bleaching formulation to mask the odor of ammonia.

The examiner points out that in an obviousness rejection, the primary reference does not need to teach every aspect of the instant invention since it is not said to anticipate the invention, merely makes the instant invention obvious to one of ordinary skill in the art. As noted by the applicant, Lang et al clearly suggest the use of perfume

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as an excipient. Lang only lacks in the teaching of a specific fragrance. Therefore the examiner relies on the secondary reference to teach the instant fragrance. As discussed above, Sekiguchi clearly teaches a perfume composition containing cis-hexenol in a hair formulation. Secondly, JP clearly teaches the use of cis-hexenol to mask odors in a hair composition; therefore providing motivation for one of ordinary skill in the art to use the instant fragrance in a hair composition. The examiner reminds the applicant that a secondary reference is relied upon for its specific teachings and does not have to teach all the elements of the instant invention; hence JP does not have to teach ammonia, monoethanolamine, or an aromatic alcohol in the composition which is taught by the primary reference. In regards to the argument that JP's cis-hexenol is masking another ingredient, it is the examiner's position that it is readily apparent and obvious to one of ordinary skill in the art that the expectation of success is high using cis-hexenol to mask odors of other ingredients in hair dyes since JP is teaching the ability of instant fragrance to generally eliminate odors such as acidic hair dye.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rejection of claims 1-3 and 5-16 under 35 U.S.C. 103(a) as being unpatentable over Lang et al (5938795) in view of Sekiguchi et al (5190747) in view of JP 05310543 is maintained.

Lang et al teach a hair dye composition containing ammonia in instant range, aromatic alcohol, a color-developing substance, and a coupling agent (Note example 3). Further, the composition may also contain perfumes (col.8, lines 1-7).

Lang et al do not specify the perfume used.

Sekiguchi et al disclose a perfume composition containing cis-3-hexanol (.5%), instant fragrances in claims, and an aromatic alcohol (2.5%) (phenyl ethyl alcohol) (Note col. 23, Perfume II). The perfume formulation is added into a hair formulation.

JP 05310543 teaches a hair dye composition containing perfume such as cis-3-hexanol to produce a dye without an unpleasant odor (Note abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sekiguchi et al's perfume composition in Lang et al's hair dye composition to mask the unpleasant odor produced by some of the components in the formulation as taught by JP 05310543.

New Rejections in Light of IDS Submitted

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9-12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05310543.

Submission of Publications translates JP's composition. The composition contains fragrance composition (.25% cis-hexenol and lavender oil), 5% benzyl alcohol, and 25% butanediol (Note Table 1 and 2).

*Note that lavender oil inherently contains linalool.

*Note the limitation "in an oxidation hair coloring or hair bleach formulation" is intended use and is not given patentable weight.

Claims 1-2, 5,7-8, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Fragrance Journal (June 1993).

The publication discloses .1% cis-hexenol applied to a base composition containing ammonium thioglycolate, 1.2% ammonia water, and propylene glycol among other components (Note Table 2 and Table 3).

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on August 12, 2002, October 2, 2002, and November 29, 2002 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 703-305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 709-3080196.

SSG
[Signature]

December 18, 2002

[Signature]
MICHAEL G. HARTLEY
PRIMARY EXAMINER